

REMARKS

Applicants' invention relates to substituted phenyluracils of the formula (I) as shown above in Claim 1 as amended and to their use as herbicides.

Rejection under 35 U.S.C. 112

Claim 1 stands rejected under 35 U.S.C. 112, second and first paragraphs, as being indefinite and not enabling with respect to a proviso at the end of the definition of group X. Applicants respectfully traverse.

With respect to the second paragraph, Applicants submit that it is well established that claims are not indefinite if they "set out and circumscribe a particular area with a reasonable degree of precision and particularity" and would be readily understood by one of ordinary skill in the art in view of the teachings of the prior art and the supporting disclosure. *In re Moore and Janoski*, 439 F.2d 1232, 1235, 169 U.S.P.Q. 236, 238 (C.C.P.A. 1971) (emphasis added); see also *In re Johnson and Farnham*, 194 U.S.P.Q. 187, 193 (C.C.P.A. 1977). That is, "[i]f the claims, read in light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." *Georgia-Pacific Corp. v. United States Plywood Corp.*, 258 F.2d 124, 136, 118 U.S.P.Q. 122, 132 (2d. Cir.), *cert. denied*, 358 U.S. 884, 119 U.S.P.Q. 501 (1958); cited with approval in *Shatterproof Glass v. Libby-Owens Ford*, 758 F.2d 613, 624, 225 U.S.P.Q. 634, 641 (Fed. Cir.), *cert. dismissed*, 474 U.S. 976 (1985), and in *Modine Manufacturing v. U.S. International Trade Commission*, 37 U.S.P.Q.2d 1609, 1617 (Fed. Cir. 1996).

The term "X_n" clearly indicates that compounds of formula (I) can have more than one substituent falling within the definition of X. To indicate that the X groups need not be identical to one another (although they all must, of course, fall within the general definition), Applicants appended the phrase "where, in the event that n is greater than 1, each X in the individual compounds can independently also have different meanings selected from those indicated." Because each X has a defined scope and the number n has definite limits, Applicants submit that Claim 1 has fixed and determinable bounds that could be unambiguously ascertained by those skilled in the art. Although Applicants believe the original language unambiguously stated their intent, they nevertheless have amended Claim 1 using more standard phrasing

to indicate that each X is defined independently when n is greater than 1. Applicants submit that they have not materially altered the scope of their claims in this respect.

In view of the above discussion, Applicants submit that Claim 1 is definite within the meaning of 35 U.S.C. 112.

With respect to the first paragraph, Applicants refer to a thorough explanation of the "enablement" and "written description" requirements given by the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences in *Staehelein v. Secher*, 24 U.S.P.Q.2d 1513 (B.P.A.I. 1992). With respect to enablement, the Board explained that "the law does not require a specification to be a blueprint" because requiring the specification to provide every minute detail "would turn [applications] into production specifications, which they were never intended to be." 24 U.S.P.Q.2d at 1516. The Board reaffirmed the well-established principle that it is only undue experimentation by one skilled in the art – not the need for some experimentation – that is contrary to the enablement requirement. E.g., 24 U.S.P.Q.2d at 1517, 1518. With respect to the written description requirement, the Board noted that this requirement is intended to ensure that applicants had possession of a claimed invention as of the filing date and reaffirmed the well-established principle that the requirement is satisfied if the application reasonably conveys this fact to those skilled in the art. E.g., 24 U.S.P.Q.2d at 1519. As previously pointed out by the C.C.P.A., the description requirement is satisfied as long as an applicant has conveyed to those skilled in the art the information that the specific subject matter has been invented. E.g., *In re Smith and Hubin*, 481 F.2d 910, 178 U.S.P.Q. 620, 624 (C.C.P.A. 1973), and *In re Smythe and Shamos*, 480 F.2d 1376, 178 U.S.P.Q. 279, 284 (C.C.P.A. 1973); see also *In re Johnson and Farnham*, 194 U.S.P.Q. 187, 195 (C.C.P.A. 1977), and *In re Moore and Janoski*, 169 U.S.P.Q. at 238-239 (which specifically recognized the interaction between the first and second paragraphs of 35 U.S.C. 112). Other often-cited decisions are fully consistent with these principles.

Therefore, Applicants have clearly conveyed their intent, particularly in view of the limited scope of X and the number n, and submit that their claimed invention is properly enabled.

Although Applicants submit that their original definition of n satisfies these principles, Applicants have amended Claim 1 (as well as Claim 2) to limit the n to no

more than 3. Applicants note in this respect that they have provided specific examples in which n can be 1 or 2 (e.g., specification at pages 35-45).

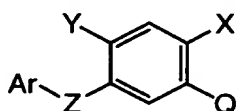
Applicants therefore respectfully submit that Claim 1 and its dependent claims fully satisfy the requirements of 35 U.S.C. 112.

Rejections under 35 U.S.C. 102 and 103

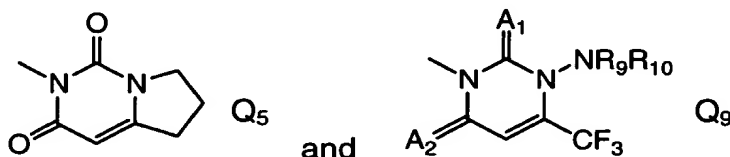
A. Rejection over Pulman et al

Claims 1-10, 15, 18, and 19 stand rejected under 35 U.S.C. 102 and 103 as being unpatentable over U.S. Patent 6,333,296 ("Pulman et al"). Applicants respectfully traverse.

Pulman et al discloses diaryl (thio)ethers having the formula



in which X and Y are hydrogen, halogen, cyano, nitro, or haloalkyl; Z is oxygen or sulfur; Q can be any of several nitrogen-containing heterocyclic groups, of which only Q₅ and Q₉ are pyrimidinyl groups



(where A₁ and A₂ are oxygen or sulfur; and R₉ and R₁₀ are hydrogen, alkyl, acyl, or alkylsulfonyl or R₉ and R₁₀ are a polymethylene group forming a ring); and Ar is optionally substituted aryl or heteroaryl. E.g., column 1, line 18, through column 2, line 40.

Applicants' claims do not include compounds in which R¹ and R² of their formula (I) form a cycle, meaning that moieties such as Q₅ of Pulman et al are excluded, and do not include 1-amino-pyrimidines in which R¹ of their formula (I) is amino, meaning that moieties such as Q₉ of Pulman et al are excluded.

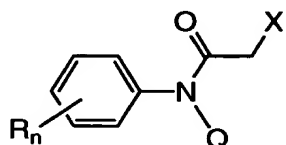
Applicants therefore respectfully submit that Pulman et al cannot anticipate and does not suggest their claimed invention.

B. Rejection over Crosby et al

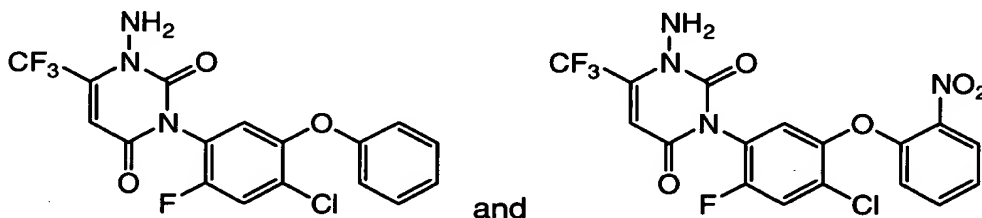
Unspecified claims (assumed by Applicants to be Claims 1-10, 15, 18, and 19) stand rejected under 35 U.S.C. 102 and 103 as being unpatentable over U.S. Patent 6,455,409 [*sic*, 6,455,469] ("Crosby et al"). If Applicants' assumption about

the claims being rejected is incorrect, Applicants request clarification in a non-final Office Action. Applicants respectfully traverse with respect to Claims 1-10, 15, 18, and 19.

Crosby et al discloses herbicidal compositions comprising **(A)** substituted acetanilides having the formula



(in which n is 1 or 2; R is hydrogen, alkyl, or alkoxy; Q is cyanomethyl or propargyl, and X is halogen) and **(B)** at least one compound selected from a large group of known herbicides. E.g., column 1, lines 15-18 and 26-53. Included among the disclosed herbicides of component (B) are 1-amino-3-(4-chloro-2-fluoro-5-phenoxyphenyl)-6-(trifluoromethyl)-2,4(1H,3H)-pyrimidinedione and 1-amino-3-[4-chloro-2-fluoro-5-(2-nitrophenoxy)phenyl]-6-(trifluoromethyl)-2,4(1H,3H)-pyrimidinedione, which have the following respective formulas



See column 2, lines 51-52 and 59-61, respectively, and column 3, lines 52-53 and 60-62, respectively, as well as Claim 8. No other phenoxyphenylpyrimidines are disclosed or suggested.

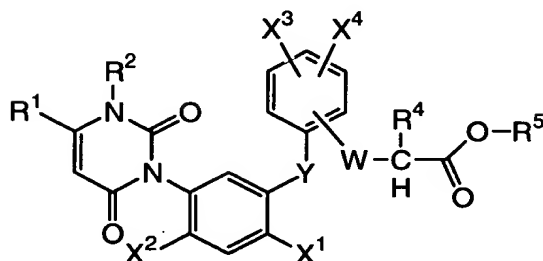
Applicants' amended claims do not include 1-amino-pyrimidines in which R¹ of their formula (I) is amino and require the phenoxy moiety to have higher order substitution than disclosed or suggested by Crosby et al.

Applicants therefore respectfully submit that Crosby et al cannot anticipate and does not suggest their claimed invention.

C. Rejection over Tohyama et al

Unspecified claims (assumed by Applicants to be Claims 1-10, 15, 18, and 19) stand rejected under 35 U.S.C. 102 and 103 as being unpatentable over U.S. Patent 6,451,740 ("Tohyama et al"). Applicants respectfully traverse.

Tohyama et al discloses herbicidal uracils having the formula



in which **W** and **Y** are independently oxygen, sulfur, imino, or alkylamino; **R¹** is alkyl or haloalkyl; **R²** is alkyl; **R⁴** is hydrogen or methyl; **R⁵** is hydrogen, alkyl, haloalkyl, alkenyl, haloalkenyl, alkynyl, or haloalkynyl; **X¹** is halogen, cyano, or nitro; **X²** is hydrogen or halogen; and **X³** and **X⁴** are independently hydrogen, halogen, alkyl, haloalkyl, alkenyl, haloalkenyl, alkynyl, haloalkynyl, alkoxy alkyl, alkoxy, haloalkoxy, alkoxycarbonyl alkoxy, or cyano. E.g., column 1, lines 23-51. Although such compounds share some structural features with some of Applicants' claimed compounds, the terminal phenyl moiety of Tohyama et al must always be substituted with a substituent -W-CHR⁴-CO-OR⁵ having no counterpart among Applicants' claimed compounds.

Applicants' claimed invention is thus not anticipated by Tohyama et al. Because Tohyama et al does not suggest substituents other than -W-CHR⁴-CO-OR⁵, Applicants submit that their claimed invention is also not rendered obvious by Tohyama et al.

In view of the preceding amendments and remarks, allowance of the claims is respectfully requested.

Respectfully submitted,

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